



Patent
Application No. P2514-000569

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP AMENDMENT
Eduardo Cue et al.)	
Application No.: 09/607,913)	Group Art Unit: 3625
Filed: June 30, 2000)	Examiner: James H. Zurita
For: STORED ORDER SYSTEM FOR)	Confirmation No.: 1176
ELECTRONIC COMMERCE)	

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of claims 1-30, 32-34, 36-38 and 40-44 set forth in the Office Action dated September 28, 2006. This request is being filed with a Notice of Appeal.

No amendments are being filed with this Request.

Background

The claims are directed to a method and system in which a user can go online to an electronic commerce site and select an order consisting of one or more items for purchase. The purchase of these items is not completed at the time of selection. Rather, a web page describing the items to be purchased, as well as other purchase information, is generated, and an email with the address of that web page is sent to the ultimate purchaser. In an example described in the application, a student can go online and select a computer system that he or she desires. The email can then be sent to the student's parents as the ultimate purchaser.

To complete the purchase of the products, the recipient of the email requests the web page, e.g. clicks on a link in the email. Upon receiving the web page, the purchaser can then carry out the final steps necessary to complete the purchase, e.g. enter payment and shipping information.

Thus, the transaction encompassed by the claimed subject matter involves two entities. A first user goes to the online store to select the item(s) to be purchased. The second entity, the "recipient" in claim 1, receives a web page describing the selected item(s). The recipient then uses the web page to complete the sale of the selected item(s) to himself or herself. In other words, it is the second entity, namely the recipient of the web page, who is the actual purchaser of the item(s) selected by the first user.

The Rejection

All pending claims stand finally rejected under 35 U.S.C. § 102, as being anticipated by the Dodd patent (US 6,633,849). The issue to be reviewed is whether the final Office Action meets the requirements for a rejection based upon anticipation, namely whether it shows that the reference teaches every element of the claim, as set forth in MPEP §2131.

The Dodd patent discloses a method and system for electronically purchasing gifts, which is essentially the converse of the subject matter recited in the pending claims. In the system of the Dodd patent, the purchaser first goes to an electronic commerce site, to select and pay for a gift for an intended recipient. Referring to Figure 5, steps 502-514 indicate the process undertaken by the purchaser to select and purchase the gift. Thereafter, a notification is sent to the intended recipient, which enables the recipient to retrieve and view information about the gift (steps 524 and 526). At this point, the recipient can decide whether to accept the gift, or exchange it for a different gift.

Claim 1 recites a method for completing purchase transactions over a computer network. The first element of the claim is "receiving order selections from a computer of a first user". In rejecting the claim, the final Office Action refers to the Dodd patent at Figure 5, steps 506-512 in connection with this claimed element.

The second element of claim 1 is "saving stored order data, the stored order data including the order selections". The rejection of the claim refers to the Dodd patent at steps 514-520. In these steps, the person who selected the gift pays for the gift, and then provides contact information for the person who is to receive the gift. The order information is stored at step 520.

The next element of claim 1 is the step of "generating a web page having an address and containing the order selections and order purchase information from the stored order data". In connection with this element, the Office Action refers to the Dodd patent at step 518. As disclosed in the specification (column 11, lines 51-57), at step 518 a notification for the recipient is generated, based upon the contact information entered in step 516. The patent describes this notification as "an electronic mail message... transmitted from gift server computer system 330 to the recipient's electronic mail address on behalf of the gift giver." There is no mention of generating a web page containing the order selections and order purchase information in connection with the notification step 518. The patent only discloses sending an email message.

Claim 1 next recites the step of "automatically producing and sending an electronic mail message having the address of the web page to a recipient..." In connection with this subject matter, the Office Action refers to the Dodd patent at steps 518 and 520. As noted above, step 518 relates to the transmission of an email message to the recipient. Step 520 pertains to storing of the order information in a gift queue.

The penultimate step of claim 1 is "in response to a request from the recipient, providing said web page to the recipient". The Office Action refers to the Dodd patent, lines 9-23. This passage in the patent discloses that, after the recipient retrieves the electronic mail notification, discussed above, the recipient connects to the gift server computer system and provides an identifier that links the recipient with order information on the selected gift. As an example of the order information, the patent refers to content area 120 in Figure 2A. This figure discloses a web page that enables the recipient to view the gift. However, there is no disclosure that this web page includes "order purchase information", as recited in claim 1.

The final step of claim 1 is "in response to a request provided via said web page from the recipient to purchase the order selections in the stored order data, completing the sale of said order selections to said recipient." Unlike each of the other steps of claim 1, the Office Action does not correlate any passage in the Dodd patent to this claimed element. The

Action merely repeats the claimed subject matter, without identifying where it is found in the reference. For this reason alone, therefore, the Office Action fails to meet the requirements of MPEP §2131. Specifically, it does not show that the Dodd patent teaches every element recited in claim 1.

Furthermore, Applicants submit that such a showing cannot be made. The claim recites that a request is provided via the web page from the recipient "to purchase the order selections in the stored order data". The Dodd patent does not disclose that the recipient issues a request to *purchase* the order selections. That is because the purchase has already been completed at step 514, prior to the time that the recipient receives the email notification. The Dodd patent discloses that once the recipient views the information in the web page of Figure 2A, the recipient is "able to accept the selected gift, exchange it for a replacement gift..., exchange it for an electronic gift certificate..., or forward the selected gift to another recipient." (Column 10, lines 23-28). It does not state that the recipient issues a request to *purchase* the selected gift.

The Office Action makes reference to the Dodd patent at column 10, lines 33-43, which describes the situation in which the gift is a conventional gift certificate from a particular vendor. The patent discloses that the recipient can exchange this gift certificate for an actual product. In this case, the computer system generates an electronic gift certificate, and allows the recipient to select a replacement gift. The patent states that the electronic gift certificate is similar to a form of currency or payment. Even if this transaction is interpreted to be a "purchase" of the replacement gift by the recipient, it does not meet the language of claim 1. Specifically, the recipient in the Dodd patent is not purchasing "the order selections in the stored order data," i.e. the selections made by the first user (the gift giver in the Dodd patent). Rather, the recipient is purchasing a *different* item, namely the replacement gift. As such, the gift certificate transaction does not function to "complete the sale of *said order selections* to said recipient", as recited in the claim.

For at least these reasons, therefore, the Office Action fails to establish that the Dodd patent teaches every element of claim 1. It does not identify what portion of the patent, if

any, discloses the last step recited in the claim, nor does it otherwise explain how the Dodd patent can be interpreted to teach that specific subject matter. Second, there is no showing that the Dodd patent discloses the generation of a web page containing order selections "and order purchase information", as recited in the claim.

Independent claims 8, 15, 22, 29, 33, 37 and 41 all stand rejected "on the same grounds as claim 1." Each of these claims recites at least one of the distinguishing features discussed in connection with claim 1, namely responding to a request provided via the web page from the recipient to purchase order selections in the stored order data, to complete the sale of the order selections to the recipient. For the same reasons, therefore, the Office Action does not establish that these claims are anticipated by the Dodd patent. Furthermore, since all other claims depend from one of these independent claims, they likewise are not anticipated.

In summary, the final Office Action fails to meet the requirement for a rejection based upon anticipation, since it does not show where every element recited in the claims is taught by the Dodd patent. As such, there is an insufficient record to be presented to the Board of Patent Appeals and Interferences. Withdrawal of the final Office Action is respectfully submitted to be in order.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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